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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91220652
Party	Defendant Sisters of Charity of Leavenworth Health System, Inc.
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Attachments	R347 Applicant's Opposition to Opposer's Motion to Dismiss.pdf(247957 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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	-----X	
)	
BLUE CROSS AND)	
BLUE SHIELD ASSOCIATION)	
)	
Opposer/Counterclaim)	
Respondent,)	
)	
v.)	Opposition No. 91220652
)	
SISTERS OF CHARITY OF)	Serial No. 86/233,170
LEAVENWORTH HEALTH)	
SYSTEM, INC.,)	
)	
Applicant/Counterclaim)	
Petitioner)	
	-----X	

APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO DISMISS

Applicant and Counterclaim Petitioner, Sisters of Charity of Leavenworth Health System, Inc. (hereinafter "SCLHS") hereby opposes Opposer and Counterclaim Respondent's, Blue Cross and Blue Shield Association (hereinafter "BCBS"), Motion to Dismiss on the grounds that BCBS's Motion to Dismiss is moot pursuant to Federal Rule of Civil Procedure 15(a) and 37 C.F.R. § 2.115.

BACKGROUND

On February 17, 2105, BCBS filed its Notice of Opposition in the above-captioned matter, alleging, *inter alia*, that SCLHS's application for registration of Application No. 86/233,170 of a Cross Design mark should be refused due to a likelihood of confusion with BCBS's pleaded marks. *See* Not. of Opp. ¶ 9. As grounds for its Notice of Opposition, BCBS asserted rights in and to at least 48 federal registrations owned by BCBS and allegedly used in

commerce, as well as various common law rights. *See* Not. of Opp. ¶¶ 7 and 8 and Ex. A.

On March 27, 2015, SCLHS filed its Answer, Affirmative Defenses, and Counterclaims. As part of its counterclaims, SCLHS sought to cancel five of BCBS's pleaded registrations, namely:

1. U.S. Registration No. 0554817 depicting a design mark of a Greek Cross (hereinafter the "817 Registration");
2. U.S. Registration No. 1,632,320 depicting a design mark of a Greek Cross (hereinafter the "320 Registration");
3. U.S. Registration No. 1,639,079 depicting a design mark of a Greek Cross (hereinafter the "079 Registration");
4. U.S. Registration No. 3,506,616 for BLUE DISTINCTION PROVIDER MEASUREMENT AND IMPROVEMENT PROGRAM (hereinafter the "616 Registration"); and
5. U.S. Registration No. 3,506,617 of BLUE DISTINCTION PROVIDER MEASUREMENT AND IMPROVEMENT PROGRAM (hereinafter the "617 Registration").

Four of the above registrations were subsequently cancelled by the Trademark Office, namely, Registration Nos. 1,632,320 and 1,639,079 (cancelled on April 14, 2015); and Registration Nos. 3506616 and 3506617 (cancelled on April 24, 2015) (hereinafter collectively the "Cancelled Registrations"). Therefore, SCLHS's counterclaims as they relate to the Cancelled Registrations are now moot.¹

¹ BCBS claims that SCLHS's counterclaims to cancel BCBS's Cancelled Registrations were improperly plead. *See* Mot. to Dismiss at pp. 5-7. Contrary to BCBS's assertion, SCLHS set forth the factual basis for cancellation due to

On May 15, 2015, BCBS filed a Motion to Dismiss pursuant to Rule 12(b)(6) asserting that SCLHS's Petition to Cancel fails to state a claim upon which relief can be granted. As a result, SCLHS subsequently filed its Amended Answer, Affirmative Defenses, and Counterclaim on June 4, 2015.

DISCUSSION

Parties in Board proceedings may respond to a motion to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(6) by filing an amended complaint. *Fair Indigo LLC v Style Conscience*, 85 USPQ2d 1536, at *3 (TTAB 2007) (citing, TBMP § 503.03 and cases cited therein). Furthermore, “[i]f the amended complaint corrects the defects noted by the moving party in its motion to dismiss, and states a claim upon which relief can be granted, the motion to dismiss normally will be moot.” *Id.* (alteration added)

The Trademark Rules of Practice indicates that “[p]leadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.” 37 C.F.R. § 2.115 (alteration added). Moreover, Federal Rule of Civil 15 states “[a] party may amend its pleading once as a matter of course within . . . 21 days after service of a motion under Rule 12(b)” Fed. R. Civ. P. 15(a)(1)(B) (alterations added); *see generally* *Pizza Donini, Inc. v. Pizza Donini, Inc. (Canada)*, 2002 TTAB LEXIS 618, at *10 (TTAB 2002) (“the filing of respondent's motion to dismiss, not being a responsive pleading, does not negate petitioner's ability to rely on Fed. R. Civ. P. 15(a) to amend its pleading once as a matter of course.”).

Here, BCBS filed and served its Motion to Dismiss on May 15, 2015. SCLHS filed its Amended Answer, Affirmative Defenses, and Counterclaim as of right pursuant to Rule 15

BCBS's failure to file Section 8 and/or Section 9 renewal affidavits. The USPTO thereafter cancelled the subject registrations within one month after SCLHS's filing of its Counterclaims.

earlier today on June 4, 2015. SCLHS filed its amendment less than twenty-one (21) days after service of the Motion to Dismiss and therefore falls within the scope of Rule 15. In its Amended Answer, Affirmative Defenses, and Counterclaim, SCLHS removes the counterclaims for cancellation of BCBS's Cancelled Registrations, as well as amplifies and clarifies the statutory basis for the remaining counterclaim for cancellation of BCBS's U.S. Registration No. 0554817 on the grounds of abandonment. See ¶¶ 16 and 17 of Amended Answer and Counterclaim. Since the Amended Answer, Affirmative Defenses, and Counterclaim will become an operative pleading in this matter, BCBS's Motion to Dismiss the previous counterclaims is moot.

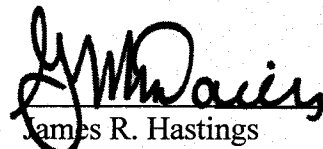
CONCLUSION

For the reasons set forth above, SCLHS respectfully request that the Board deny BCBS's Motion to Dismiss as moot.

Respectfully Submitted,

Dated: June 4, 2015

By:



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CERTIFICATE OF SERVICE

I, Meaghan C. Machcinski, do hereby certify that on June 4, 2015, a true copy of Applicant's Opposition to Opposer's Motion to Dismiss was duly served upon the Opposer's counsel of record by placing a true copy in the United States Mail with sufficient postage thereon to carry same to its destination via First Class Mail, and addressed to:

Hanson Bridgett LLP
425 Market Street, 26th Floor
San Francisco, CA 94105
Attention: Garner K. Weng, Esq.

